

## REMARKS

Claims 1, 3-6, 8-11, 13-16, 18-21, and 23-26 are *pending* in the application. Claims 2,7,12,17,22 have been cancelled. There are *no allowed* claims. Claims 1, 11, and 21 are the only independent claims. All pending claims are *finally rejected* on the basis of 35 U.S.C. §103.

### *Claim Rejections – 35 USC § 103*

Claims 1, 3-6, 8-11, 13-16, 18-21, and 23-26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Craven et al. (U.S. Patent 5,157,424) in view of Merry et al. (U.S. Patent 5,178,418).

#### ***The Invention***

Applicants essentially claim a document having corresponding first and second printed matter representative of individual-specific information, the document being particularly characterized in the location, scale, and color of its second printed matter. In particular, the scale of the second printed matter is “significantly smaller” than the scale of the first printed matter. Further, the location of the second printed matter (*i.e.*, the “second location”) is “spaced” from the location of the first printed matter. And, the color of the second printed matter is “selected to effect minimal contrast between said second printed matter ... and its immediate background *so as to hide* said second printed matter”.

#### ***The References***

Applicants have reviewed the cited art references and have considered objectively the examiner’s comments. Applicants, however, do not agree with the Examiner’s conclusions. The invention defined in the claims as amended is not foreshadowed by the cited art references.

The Craven reference discloses a method and apparatus for manufacturing tamper-resistant identification cards containing a first signature at a first location and a duplicate digitized signature superimposed over a digitized image (photograph) at a second location. Both signatures are identical in size and enable an inspecting authority to readily, *i.e.*, without magnification determine whether the tampered duplicate signature on the photograph is the same as the operator’s untampered signature, the one that properly belongs to the document. In the use of Craven’s identification card, it is important that both signatures be perceptible

without magnification. Further, while Craven discloses printed matter having a color contrasting with the background of the document, and may permit a reduced size of the duplicate signature, there is no suggestion or teaching by Craven to minimize the contrast so as to hide the second printed matter from the naked eye. In fact, Craven strives to reveal both signatures to enable one to readily detect tampering of the photograph, *i.e.*, the tampered signature as well, which has been superimposed on the photograph.

The Merry reference, on the other hand, is a security device containing reduced size alphanumeric characters, which when ordinarily viewed appear uniform but with the aid of a magnification means provide a latent image due to the phase shifting of the characters, the latent image being indiscernible to the naked eye.

While Merry discloses magnification means of hidden alphanumeric text to reveal a latent image, the method is not suitable to produce individual cards that provide identifying information. Furthermore, there is no suggestion or teaching in Merry to provide duplicate identifying information which is only revealed with magnification. In contrast, Merry provides groups of characters which are phase shifted to reveal a latent hidden image upon magnification.

Applicants respectfully submit that there is no suggestion or teaching in the references that would lead one of ordinary skill in the art toward applicants' invention. To the contrary, the Craven reference teaches away from the invention by providing a second printed matter which is readily viewable without magnification and is intended to be visible. Likewise, the Merry reference teaches away from the invention by providing microprint which covers the entire document and is hidden unless viewed with magnification. Merry does not have a hidden duplicate identifying information which provides authentication for security documents.

***The Office Action states:***

On Page 3, Item 2 of Office Action, Examiner refers to Col 3, Line 1-5 of the Craven Reference (reproduced below) to conclude that the contrast provided by Craven makes it obvious to one having ordinary skill in the art ***at the time the invention was made*** to select a color to contrast at any degree whether it is at a maximum or minimum.

*"In accordance with the present invention, the photograph has superimposed thereon a reproduction 20 of the operator's signature. This reproduction 20 is a precise duplicate of the signature 16 appearing at the bottom of the license, except that it may be reduced in size and its color may be inverted to contrast with the background of the photograph. By providing identical reproductions of the same signature at two different locations on the license, any authority to whom the license is presented can readily determine whether the photograph is the one that properly belongs to that of the license".*

***Applicant's Response:***

Applicants respectfully disagree with Examiner's view that it is obvious for one to arrive at the Applicant's invention from the Craven reference. To the contrary, Craven discloses an identification document that has a duplicate signature (second printed matter), that is readily seen by any authority to whom the license is presented. If there was a tampering of the Craven type document, it would be readily detected because the signatures do not match on the first location and the second location (the picture). Applicant's invention on the other hand, permits the second printed matter to be *hidden*, and requires it to be so *hidden*, such that the counterfeiter does not know of the presence of the second printed matter and therefore would not attempt to forge it. Only the forensic official examining the document at a later time would know, upon magnification, if indeed, the document had been forged by looking at the second printed matter using magnification means. *Craven and the invention provide identification documents, but perform different functions, the former by providing a readily visible security feature for discouraging an attempt at tampering, and the latter, by providing a hidden security feature to enable detection by subsequent investigation of an already tampered document.* Another distinction is that Craven uses the whole signature in a second location for ready comparison, whereas the invention may have parts of the first printed matter, for example, the year of the date of birth of the holder of the document.

The disclosure of microprinting in the Merry reference has no bearing on the claimed invention, because Merry teaches away from using identifying information by describing the preferred methods of printing the character array to be "intaglio and offset lithography" (col.3 line 38). The methods suitable to produce applicants' invention for conveying identifying information renders the cited art (*i.e.*, Merry) unsatisfactory for its intended purpose (*i.e.*, latent images comprising phase shifted micro printing). Examiner's contentions of obviousness based on the Merry and Craven references change the principle of operation of the references themselves.

*In addition to maintaining the arguments proffered earlier, Applicants furthermore believe that a significant distinction must be made between the subject matter of the invention and the Craven reference. Craven is an identification document that provides a second printed matter (copy of a signature) designed to be duplicated and placed such that it is easily viewed by the casual observer, unaided by any magnification means. Craven also intends to print this second printed matter in a picture area. Since Craven is viewable to the user, and Polascripting (Polaroid's proprietary technology used in this invention) is hidden and is intended to be viewable and viewed only by a trained Examiner, Craven is an Overt Security Feature designed to be viewed and Polascripting (the present invention) is a Covert Security Feature designed to be hidden. Although both Craven and the Invention are both used for authentication and tamper deterrence, PolaScripting provides a substantially more effective tamper proof/detection feature, since the counterfeiter will not know that the second micro printed matter is present and thus will not attempt to alter the second printed matter on the identification document so as to make the counterfeit obvious to the trained observer, whereas in Craven the document holder understands that the duplicate signature feature is present and might attempt to counterfeit it which may or may not be thereafter detected depending upon the skill of the counterfeiter. To bring this distinction to light, Applicants respectfully amend independent claims 1, 11, 21 to insert the language "to be hidden" to readily distinguish the invention from Craven. The claims as amended do not insert new matter, or require a new search, and address fully the Examiner's rejections.*

#### **PRIMA FACIE CASE OF OBVIOUSNESS**

Applicants respectfully submit that Examiner's rejections do not establish the *prima facie* case for obviousness. To establish a *prima facie* case of obviousness, three conditions must be met.

- 1. There must be some suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*
- 2. Second, there must be a reasonable expectation of success.*
- 3. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*

**SCOPE AND CONTENT OF PRIOR ART (MPEP § 2141.01)**

***Content of the Prior Art is determined at the time the invention was made to avoid hindsight.***

At the time the invention was made, Craven was not available to teach or suggest a hidden second printed matter. Therefore, it is improper hindsight analysis to make such a conclusion.

**THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION (MPEP § 2143.01)**

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available available to the public (*In re Fine, In re Jones*).

**THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

There is no suggestion or motivation to teach the second printed matter to be hidden, if it were, it would not work as expected since Craven relies on the second printed matter to be seen.

Craven or Merry alone or combined will not be able to produce Applicant's invention. The claim limitations such as duplicate second printed matter that is hidden to a naked eye and can only be revealed upon magnification are neither taught nor suggested by any of the references relied upon by the Examiner.

In light of the above analysis, Applicants respectfully submit that Examiner's rejections fail to meet the *prima facie* case of obviousness. Therefore, Applicants believe that the invention defined in independent claim 1 is obvious, and accordingly, request withdrawal of the examiner's rejection. Claims 3 to 6 and 8 to 10 are dependent on claim 1. Withdrawal of the rejection of these claims is also requested.

While applicants have confined their arguments to independent claim 1, the arguments are equally applicable to independent claims 11 and 21. Both claims have been amended to conform with the amendments to claim 1. Withdrawal of the rejection of claims 11 and 21, and their dependencies, is requested.

**Conclusion**

The pending claims distinguish over prior art. The claims are in proper form. The application is believed to be in condition for allowance.

Respectfully Submitted,

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## VERSION WITH MARKINGS TO SHOW CHANGES MADE

*Based on previously entered amendments*

(CHANGES SHOWN IN BOLD, UNDERLINE (added), and BRACKETS (delete))

1. (Twice Amended) A document containing non-identifying and identifying information, said document comprising:

first printed matter rendered at a first location on said document and at a first scale enabling said first printed matter to be resolved by a viewing person without magnification;

second printed matter representing said first printed matter rendered at a second micro scale and at a second location on said document and in a second color, said second micro scale being significantly smaller than said first scale, said second location being spaced from said first location, and said second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background so as to hide said second printed matter from the naked eye;

wherein said second printed matter is hidden, and cannot be perceived without magnification of the second printed matter; and

wherein said first and second printed matter conveys identifying information.

11. (Twice Amended) A system of tamper resistant identification documents comprising:-

a plurality of identification documents, each of said documents displaying information specific to a particular person;

each of said documents comprising first printed matter rendered at a first location on said documents at a first scale enabling said first printed matter to be perceived without magnification; and second printed matter representing said first printed matter at a second micro scale and rendered at a second location on said documents and in a second color, said second micro scale being significantly smaller than said first scale, said second location being spaced from said first location, and said second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background so as to hide said second printed matter from the naked eye; [.]

wherein said second printed matter is hidden, and cannot be perceived without magnification of the second printed matter, and wherein said first printed matter of each card is specific to the particular person identified in each card.

21. (Twice Amended) A method of printing a document containing identifying information for a particular person comprising:

providing a base card;

printing information which is specific to the particular person identified on said base card at a first location and at a first scale enabling said printed information to be perceived without magnification; and

representing said information on said base card at a second micro scale, and at a second location on said document, and in a second color, said second micro scale being significantly smaller than said first scale, said second location being spaced from said first location, and said second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background so as to hide said second printed matter from the naked eye, and wherein said second printed matter is hidden, and cannot be clearly perceived without magnification of the second printed matter.